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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/400,336	03/08/95	HOCKERSON	S A-59987-2/RE

32M1/1113
FLEHR HOBACH TEST ALBRITTON & HERBERT
FOUR EMBARCADERO CENTER SUITE 3400
SAN FRANCISCO CA 94111

KAVANAUGH EXAMINER

ART UNIT	PAPER NUMBER
3208	

DATE MAILED: 11/13/95

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-392. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input checked="" type="checkbox"/> <u>sub. PTO-948</u> |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-4 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 1-4 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received
☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Part III DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Claims 1-4 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "sufficient", in line 9 of claim 1 and line 3 of claim 3, is vague and indefinite as it is not clear as to the metes and bounds of such an expression.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

3. Claims 1-4 are rejected under 35 U.S.C. § 103 as being unpatentable over US 4309832 (Hunt) in view of WO 9105491 (Ellis).

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Hunt shows an athletic shoe comprising an upper (12), a sole, a rigid heel counter (see the heel counter in figure 1 positioned above the midsole 14, moreover Heel counters are well known and conventional in the art to provide reinforcement in the back of shoe uppers) and a channel (30) in the bottom surface extending through the peripheral rim having interior sidewalls which are spaced apart a distance and terminate adjacent the upper housing substantially as claimed except for the channel extending longitudinal dividing the heel portion into at least a pair of lateral adjacent compression elements. Ellis teaches a shoe sole (figures 13A, 13C and 13D) with a transversely disposed channel and/or slits (113) and at least one longitudinal channel (151) [plurality of channels] dividing the heel portion into at least a pair of lateral adjacent compression elements [plurality of compression elements]. See figure 7D and 15G which show the channels spaced apart a sufficient distance to isolate the compression elements from motion of the interior sidewalls during heel strike of the sole onto a surface. The channels/slits of Ellis also terminated adjacent the upper housing. It would have been obvious to provide the shoe of Hunt with one or more of the longitudinal spaced channels, as taught by Ellis, to provide sufficient flexibility to parallel the frontal plane deformation of the foot sole, see page 1 lines 5-17 of Ellis. With regard to claim 2, Ellis teaches that there may be multiple slits or only

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one slit, page 10, lines 1-7. Ellis shows slits (151) extending only through the heel portion in figure 13A and 13C. Therefore, it would be an obvious design choice to provide only a longitudinal channel (slit) extending through only the heel portion of the sole depending on the flexibility desired and on the particular use of the athletic shoe.

4. Claims 1-4 are rejected under 35 U.S.C. § 103 as being unpatentable over US 4322895 (Hockerson) in view of WO 9105491 (Ellis).

Hockerson shows an athletic shoe comprising an upper, a sole, a rigid heel counter substantially as claimed except for a channel extending longitudinal dividing the heel portion into at least a pair of lateral adjacent compression elements. Ellis teaches a shoe sole (figures 13A, 13C and 13D) with a transversely disposed channel and/or slits (113) and at least one longitudinal channel (151) [plurality of channels] dividing the heel portion into at least a pair of lateral adjacent compression elements [plurality of compression elements]. See figure 7D and 15G which show the channels spaced apart a sufficient distance to isolate the compression elements from motion of the interior sidewalls during heel strike of the sole onto a surface. The channels/slits of Ellis also terminated adjacent the upper housing. It would have been obvious to provide the shoe of Hockerson with one or more of the longitudinal spaced channels,


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as taught by Ellis, to provide sufficient flexibility to parallel the frontal plane deformation of the foot sole, see page 1 lines 5-17 of Ellis. With regard to claim 2, Ellis teaches that there may be multiple slits or only one slit, page 10, lines 1-7. Ellis shows slits (151) extending only through the heel portion in figure 13A and 13C. Therefore, it would be an obvious design choice to provide only a longitudinal channel (slit) extending through only the heel portion of the sole depending on the flexibility desired and on the particular use of the athletic shoe.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted Kavanaugh whose telephone number is (703) 308-1244.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1148. Facsimile correspondence for this application should be sent to (703) 305-3579.


Ted Kavanaugh
Patent Examiner
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TK
November 8, 1995